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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANT(s):	Seymour		
SERIAL NO.:	08/987,995	ART UNIT:	2686
FILING DATE:	12/10/1997	EXAMINER:	Mehrpour, Naghmeh
TITLE:	PORTABLE ELECTRONIC APPARATUS		
ATTORNEY DOCKET NO.:	200-007711-US (PAR)		

#25

Commissioner of Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PETITION UNDER 37 C.F.R. §1.181 TO WITHDRAW OFFICE ACTION AFTER DECISION ON APPEAL

I. INTRODUCTION

Applicant respectfully petitions, under 37 C.F.R. 1.181 and MPEP §1002.02(b)(3) for withdrawal of the Office Action mailed May 5, 2004 (Paper No. 22).

Under the provisions of 37 C.F.R. §1.198, cases will not be reopened or reconsidered by the primary Examiner...and then only for the consideration of matters not already adjudicated, sufficient cause being shown. Paper No. 22 is an attempt to re-adjudicated issues decided by the Board without sufficient cause being shown. Thus, there are no grounds to reopen prosecution and the action must be withdrawn.

This petition is being filed pursuant to 37 C.F.R. §1.181 and MPEP §1002 within two months of the action complained of.

II. FACTS

A decision on appeal (the "Decision") by the Board of Patent Appeals and Interferences (the "Board") was mailed on March 31, 2003. Subsequent to the Decision, the Examiner reopened prosecution and an Office Action was mailed November 20, 2003 (Paper No. 19). Responsive to Applicant's petition of January 23, 2004 under 37 C.F.R. §1.181 requesting a review of the validity of the Examiner's action in reopening prosecution following the Decision, a second, non-final action was mailed on May 5, 2004. (Paper No. 22). This petition now follows.

III. DISCUSSION

It is respectfully submitted that both the Office Action mailed November 20, 2003 and the Office Action mailed May 5, 2004 are inappropriate and should be withdrawn since prosecution of this application after the Decision has not been reopened in accordance with 37 C.F.R. §1.98. The reopening of prosecution in this application is not proper because the Examiner is merely reasserting a basis of rejection that was reversed by the Board, and is attempting to reconsider issues already adjudicated, without sufficient cause being shown (M.P.E.P. §1214.07, 37 C.F.R. §1.198).

In the Decision, the Examiner's rejection of claims 12-19 under 35 U.S.C. §103(a) over Saji in view of French was reversed. (Paper No. 18, page 4). The Examiner now attempts to use the same broad conclusory statements regarding the teachings of Saji, now in combination with Yamamoto, to obviate Applicant's invention, without paying heed to the Decision. This is improper reconsideration of matters previously adjudicated.

Applicant's invention is directed to overcoming ability to easily misplace or steal radio telephones. (Paper No. 18, page 1 to page 2, line 8). Saji is not relevant in this regard. In the Decision, the Board states that "Saji does not recognize the problem of theft for cordless telephone sets. Saji is concerned solely with the problem of insuring that the cordless radio set is being properly charged once it [is] placed in the charging stand." (Paper No. 18, page 8, lines 18-21). Significantly, the Board goes on to state "[w]e fail to find that Saji suggests a reason to provide an anti-theft mechanism for Saji's cordless telephone. Furthermore, we find that Saji is only concerned with the problem of proper charging. Therefore, we fail to find that one of ordinary skill in the art would have reason to take the Saji cordless telephone set and modify it and protect it against theft." (Paper No. 18, page 9, lines 18-26).

Thus, the Board makes it quite clear that Saji cannot be used to satisfy the burden of showing obviousness of Applicant's invention for purposes of 35 U.S.C. §103(a). As noted by the Board, "the Examiner can only satisfy the burden of showing obviousness of the combination only by showing some objective teaching in the prior art or individual to combine the relevant teachings of the references." (Paper No. 18, page 7, lines 16-21). Saji does not provide any such evidence. Nothing about Saji or Applicant's invention has changed that would affect this determination by the Board.

However, in the Office Action mailed May 5, 2004 (Paper No. 22), the Examiner once again reasserts the use of Saji as the primary basis for rejection under 35 U.S.C. §103(a). "Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the above teaching of

Yamamoto with Saji, in order to enable the user to protect her/his cell phone from being used in case of being stolen." (Paper No. 22, page 3, lines 5-8). However, the issue of Saji has already been adjudicated by the Board where they state that "we fail to find that one of ordinary skill in the art would have reason to take the Saji cordless telephone set and modify it and protect it against theft." (Paper No. 18, page 9, lines 18-26). Thus, the Examiner's use of Saji in Paper No. 22 is an impermissible attempt to re-adjudicate the issue of Saji. This is not allowed under M.P.E.P. §1214.07 and 37 C.F.R. §1.198.

Since the Board has already decided that Saji does not provide an objective teaching that suggests Applicant's claimed subject matter, the Examiner's use of Saji in Paper No. 22 is an impermissible attempt to consider matters already adjudicated. Thus, there is no basis or cause to reopen prosecution on this application. Therefore, Paper No. 22 (and Paper No. 19) must be withdrawn.

Furthermore, the reassertion of a reference, the applicability of which was decided in the negative by the Board, is not a reason to reopen prosecution. The Examiner must have "specific knowledge of the existence of a particular reference or references which indicate nonpatentability of any of the appealed claims as to which the Examiner was reversed." Only in that case can the Examiner submit the matter to the TC Director for authorization to reopen prosecution under 37 C.F.R. §1.198 for purpose of entering the new rejection. (M.P.E.P. §1214.04) There is no such indication here and the reassertion of Saji is inappropriate.

The Decision did not sustain the Examiner's rejection of claims 12 through 19 under 35 U.S.C. §103(a) as being unpatentable over

Saji in view of French. This complete reversal of the Examiner's rejection brings the case up for immediate action by the Examiner. (M.P.E.P. §1214.04). However, the "Examiner should never regard such a reversal as a challenge to make a new search to uncover other and better references." (M.P.E.P. §1214.04). Rather, the application is thus returned to the Examiner to carry into effect the decision. (37 C.F.R. §1.197). The Board did not issue any statement that would constitute a new ground of rejection of the claims. Nor did the Board include or allow a remand. (see 37 C.F.R. §1.196). Thus, more appropriately, the Examiner should have allowed this application to issue.

Therefore, Applicant respectfully requests that both Office Actions be withdrawn and purged from the file.

Should any unresolved issues remain, the Examiner is invited to call Applicants' attorney at the telephone number indicated below.

The Commissioner is hereby authorized to charge payment for any fees associated with this communication or credit any over payment to Deposit Account No. 16-1350.

Respectfully submitted,

Geza C. Ziegler, Jr.
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20 MAY 2004
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